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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/071,490

02/07/2002

J. Alexander Marchosky

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06/29/2005

SONNENSCHN NATH & ROSENTHAL LLP

P.O. BOX 061080

WACKER DRIVE STATION, SEARS TOWER

CHICAGO, IL 60606-1080

EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,490

Applicant(s)

MARCHOSKY, J. ALEXANDER

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-60 and 65-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-60 and 65-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>6/09/05 & 5/17/05</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Examiner acknowledges receipt of terminal disclaimer filed 05/20/05, amendment and remarks filed 02/28/05. Claims 56-60 and 65-103 are pending.

Claim Rejections - 35 USC § 102

1. Claims 56, 68 and 69 remain rejected under 35 U.S.C. 102(e) as being anticipated by Muschler (US 6,049,026).

Applicants argue that while Muschler discloses a long list of possible materials, Muschler does not specifically disclose a mixture of hyaluronic acid, cancellous bone and demineralized bone matrix.

2. Applicant's arguments filed 02/28/05 have been fully considered but they are not persuasive.

Although Muschler discloses a long list, there is nonetheless a disclosure and the list is not exhaustive. Column 4, lines 1-10 and 62 talks about demineralized bone matrix, hyaluronic acid and cancellous bone. Muschler does not state that one or the other may be used. It is noted that Examples 3 and 5 uses demineralized cancellous bone matrix.

Claim Rejections - 35 USC § 103

3. The rejection of claims 1-4, 18, 32 and 50 under 35 U.S.C. 103(a) as being unpatentable over Petrie et al. (US 6,017,940) and Brown et al. (US 5,629,287) is moot in light of the cancellation of those claims.

4. Claims 57-60, 65-67 and 70-103 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Muschler (6,049,026) in view of applicant's admitted prior art.

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Applicant argues that there is no method of bone formation in Muschler; and Muschler does not disclose a mixture of hyaluronic acid, cancellous bone and demineralized bone matrix.

5. Applicant's arguments filed 02/28/05 have been fully considered but they are not persuasive.

As discussed above, Mueller provides a disclosure for a bone material that comprises hyaluronic acid, cancellous bone and demineralized bone matrix. Regarding applicant's argument that Muschler does not disclose method of bone formation, it is respectfully noted that Muschler discloses bone graft material and how to prepare the bone material for an intended use of implanting the bone graft into a subject in need thereof (see column 5, lines 29-32 where implantation is allowed/permitted).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Blessing Fubara
Patent Examiner
Tech. Center 1600


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600